

## Statement of the Case

The essential facts and the conclusions of the courts below are stated in the petition.

It may be added that the Control invention overcame problems that had baffled far more numerous workers for a far longer time than might appear from the opinion below. Sprayers for centrifugals had been rendered mechanically operative long before *Carlson's* proposal, first by Roberts and afterward by *Knapp* and others. But the larger and relevant problem of mechanically controlling the sugar centrifugal itself had escaped numerous attempted solutions. Many were cited in the file wrapper of the Control patent (Ex. BB) and many in respondent's bill of particulars (RE. 1-2), dating back to before 1900. Respondent relied unsuccessfully in the district court upon the *Herr* proposals filed in 1915 (Ex. QQ-2, RB. 800) and 1923 (Ex. QQ-1, RB. 798) and the *Andrews & Newman* proposal filed in 1922 (Ex. R, RB. 776). Several other attempts of early date are described in *Deerr*, "Cane Sugar" (1921), page 427 (Ex. 7, RB. 699, RA. 95), which states that "no great success has been obtained so far".

## Specification of Errors

The Circuit Court of Appeals erred:

1. In circumscribing claims of the Control and the Brake Cooling patents to illustrative details of the respective specifications not claimed as the Roberts inventions.
2. In holding the disclosure of the copending *Carlson* patent to be a limitation upon the scope of the Control patent.
3. In holding the Control and Brake Cooling patents not infringed by respondent's manufacture and sale of

structures embodying the parts, improvements and combinations disclosed and claimed as the Roberts inventions.

4. In according presumptions of operability and sufficiency of disclosure to an unpatented part of the specifications of the *Holland* patent.

5. In holding claims 10 and 12 of the Separator patent invalid as anticipated by *Holland*.

6. In holding it immaterial whether any contribution to the sum of knowledge was made by matter contained in a prior patent and offered in anticipation of claims granted for a later successful invention.

7. In holding claim 8 of the Brake Cooling patent invalid because the novelty it distinguishes seemed to the court either "useless" or so simple a change that it "could be no invention".

8. In reversing the judgment of the district court as to all claims in issue except claim 8 of the Brake Cooling patent, and as to costs, and in affirming the district court as to that claim.

## ARGUMENT

**A sound public policy applicable to this case holds the claims of a patent as the measure of its scope and forbids circumscribing them to details not imported by a fair construction of their terms.**

The constitutional purpose to promote the progress of the useful arts is implemented by patent laws which authorize the grant of exclusive rights to whomever has invented any new and useful art or machine, or any new and useful improvement thereof, and whose application duly made has been examined by an expert in the Patent

Office and found to comply with the requisites. R. S. § 4886, U. S. Code, Title 35, Sec. 31.

Among the requisites is that there shall be filed a written description which, in case of a machine, shall explain the *best mode* in which the applicant has contemplated applying the principle of his invention "so as to distinguish it from other inventions". And then "he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention". R. S. § 4888, U. S. Code, Title 35, Sec. 33.

So the invention patented is the matter claimed, of which the mode of application explained in the description is illustrative but not restrictive. The focal point of examination is the claims. When allowed in mechanical cases they presumably have been found by a qualified expert to distinguish from other inventions some part, improvement or combination of a machine of which an illustrative embodiment has been sufficiently explained, which the applicant was the first to invent, and which at the time of his invention was new and useful and involved ingenuity beyond that then expectable of mechanics skilled in the art.

The claims thus give a workable measure of the novel matter that may or may not be used during the life of the patent without license. The description does not. It is explanatory and detailed, and patentable invention seldom lies in mere detail. It often presents but a crude exemplification, for the law encourages early filing once an invention has been publicly disclosed, while the evolution of the first working organization to ultimate forms often takes years and great expense. To encourage his original efforts and their development the law protects the inventor, not merely as to details but as to the substantial features distinguishing his advance from other inventions. They are measured by the claims. To the

extent of their advantages and success he may be rewarded; while the public gains knowledge of the new features and their advantages, and the public is apprised by the claims of what the patent exclusively controls for seventeen years, no matter in what form others might make it appear.

“But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention”, *Smith v. Snow*, 294 U. S. 1, 11, 12.

“In making his claim the inventor is at liberty to choose his own form of expression, and *while the courts may construe the same in view of the specifications and the state of the art, they may not add to or detract from the claim.* *Cimiotti v. Am. Fur*, 198 U. S. 399, 409. (Italics added.)

Courts may not properly restrict a claim to a particular form of machine unless it cannot fairly be construed otherwise. *Winans v. Denmead*, 15 How. (56 U. S.) 330, 341. So strong is the principle involved that the judicial construction of claims in a manner different from the import of their terms has been aptly described by this court as “unjust to the public, as well as an evasion of the law”. *White v. Dunbar*, 119 U. S. 47, 51; *Minerals Separation v. Butte*, 250 U. S. 336.

Even where claims were limited in terms to a device “substantially as described” this court held that “another construction, which would limit those words to the precise mechanism described in the patent, would be so obviously unjust that no court could be expected to adopt it.” *Hobbs v. Beach*, 180 U. S. 383, 399.

Yet the Circuit Court of Appeals in this case has thus limited claims which contain no restrictive words. Where Roberts had invented new control combinations and was granted claims for them, the court has “circumscribed” his patent to mechanical details of a timer element. Where Roberts invented a new brake cooling system for

maintaining a body of water in the brake drum and cyclically replacing the heated water by cool water, and was granted claims for the brake drum construction and the intake control distinguishing this system, the court has "circumscribed" his patent to details of a valve operating mechanism.

The result of courts changing patented claim is to nullify the lawful expectations upon which developments are ventured, business is created and contracts are laid, as well as to destroy the measure by which men may determine what is or is not open to free business use. This can be illustrated by the facts of this case:

Roberts held the assets of insight, ingenuity and a zeal to make sugar centrifugals perform as they never had (RA. 126, 1-4-182, 187-188), but he was handicapped by lack of formal education, lack of technical assistance and dependence upon the returns from his improvements for sustaining financial resources (RA. 270). So he relied, and had to rely, upon the protection of the patent law, and not merely as to the form of machine in which his improvements were first disclosed.

His Control invention started in 1923 in one form (RA. 191-194), progressed in 1924 through another which was built but was discarded in early 1925 as too complicated and expensive (RA. 202-206); then was worked upon in a form to use electrically motivated elements (RA. 207); and in October of 1925 it attained the form first used successfully for sugar manufacture, which is the one illustrated in the Control patent (RA. 221). But the development did not stop there. Other forms followed as shown in his related patents\*, Nos. 1,719,132, 1,861-

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\* These copending patents show common subject matter claimed basically in the Control patent. The Circuit Court of Appeals disregarded them in considering the Control patent, but they are pertinent to its construction. *Weber Electric v. E. H. Freeman*, 256 U. S. 668, 676; *Monitor v. Williamson*, 299 Fed. 1, 3 (C. C. A. 6th, 1924).

978 and 2,145,633 (Ex's. 2, 3 and 4, RB. 688-692, RA. 83); and then still others among which were some using electrically motivated timers and connections (RA. 169-171), as do respondent's machines.

Roberts' need and expectation of patent protection for the full substance of his advance appear clearly from letters he wrote as the developments progressed—those of 1924 and 1925 to patent counsel (Ex's. 26, 29 and 30, RB. 706-709, RA. 195, 206, 207), and those of October, 1925, to an associate (Ex's. 32 and 33, RB. 710-714, RA. 222). In the last he stated:

"I am going to Boston tonight so as to get all the protection it is possible to get on this controlling arrangement. I am also taking along our old records showing when we first started development work \* \* \*. I want to cover this both electrically and mechanically if possible. As soon as our competitors see how simple this is they will no doubt try to infringe."

This prediction was soon realized by the activities of *Steps* and his company, which became licensed to continue with its different forms of the Roberts combinations when the Control patent had issued (RA. 304-306). It was realized again in 1936 by respondent's activities giving rise to this suit (RA. 306-309).

To confine the claims of the Control and Brake Cooling patents to their illustrative mechanical forms, as the Circuit Court of Appeals has done in this case where their terms cannot fairly be so construed, seems clearly "an evasion of the law", "so obviously unjust that no court could be expected to adopt it", and contrary to the applicable decisions of this court.

**The court was not justified by either the specifications or the prior art in refusing to enforce valid claims of the Control and the Brake Cooling patents, or in circumscribing them to illustrative details.**

The rights secured by a patent are made enforceable by law, and it is the plain duty of a court to enforce valid claims as granted, according to a fair construction of their terms, unless the party charged with infringing them makes out a defense.

Here the respondent's defenses were invalidity and non-infringement of the claims. To their presumptive validity, however, the district court added affirmative findings of validity as to the claims of the Control patent and claim 9 of the Brake Cooling patent, and those findings were not reversed by the Circuit Court of Appeals. Indeed, it referred to the Control invention as "meritorious" and did not deny that each patent distinguished a useful and important advance.

The comments of the Circuit Court of Appeals as to the quantum of ingenuity it might seem theoretically to require to add "drying" control to Carlson's alleged operations, or to turn off the cool water supply to a brake drum as it came to rest, cannot be taken as holdings that those claims are invalid. It is evident from the opinion that the court did not adjudicate their validity and did not reverse, but rather accepted, the district court's findings that they were not anticipated and were for important advances having the character and effects of patentable inventions. It did not hold the claims invalid as importing nothing beyond the skill of mechanics at the time of Roberts' work; that would have violated the facts.

The defense remaining, then, was non-infringement. The construction of the patents called for in that regard may properly invoke their specifications and the prior art for a better understanding of the terms and scope of the claims.

But the quantum of ingenuity that might seem entailed in a theoretical endeavor to satisfy some of their distinguishing terms, such as in theoretically adding "drying" control to *Carlson* or merely turning off a cool water supply to a brake, plainly is not relevant to the construction of the claims.

That this be so inheres in the rule that the claim measures the scope of protection, for otherwise not the claim but theoretical considerations of degrees of ingenuity divorced from practical things would be the measure of what a valid patent does or does not cover. So it was held in *Mason v. Graham*, 23 Wall. (90 U. S.) 261, 274, that evidences of a state of the art which did not anticipate an invention would not justify construing it to cover only a combination having an element of particular form—

"they exhibit no such state of the art as requires that construction to be given to the patent, and we cannot perceive that such a construction is justified by the language of the specification and claims."

That the claims of the Control patent and claim 9 of the Brake Cooling patent are not restricted to the illustrative embodiments of the specifications is plain from reading them, and from the opinion and findings of the district court, and from the observation of the Circuit Court of Appeals that "all claims are in some respects more general than the specifications" (RE. 173).

That these claims are not required to be restricted to avoid covering prior art is equally plain.

As to the Control patent, the district court held that *Carlson's* proposal "is not the Roberts invention" (RA. 38). The Circuit Court of Appeals acknowledged that Roberts provided operations not found in *Carlson* (RE. 169, 172), although their import was misunderstood and confused with vague concepts of "automaticity." Claim 3, for example, specifies a combination of five elements as a com-

plete, operative entity which *Carlson* lacks altogether, and *Carlson's* combination of three elements has no element in common with that claimed, unless it be the timer element which he proposed and disclosed incompletely for a different use. Claims 1, 4, 5, 9 and 10 each distinguishes combinations unlike *Carlson's* in still further respects.

The most respondent's expert could say of *Carlson* was that its combination would correspond to a hypothetically isolated segment of respondent's machine (RA. 551), far less than the machine as a whole (RA. 549-551) and as far from the entity that is the Roberts invention.

As to the Brake Cooling patent, its system embodies two distinct elements of novelty which are distinguished from everything old by claims 8 and 9. Since the elements these claims specify were essentials of an important advance in the art, the Circuit Court of Appeals was not justified in confining claim 9 to details destructive of its intended substance and not within the fair import of its terms.

### **The Use Made of Carlson Unduly Extended the Rule of the Milburn Case**

The courts below agreed that *Carlson's* application did not disclose the combinations claimed in the Control patent. His combination, elements, operation and results were all different.

This being so, *Carlson* does not demonstrate that Roberts was not the first inventor of the claimed combinations, but rather the contrary. The defense of prior invention under Revised Statutes § 4920, U. S. Code, Title 35, Sec. 69, was not made out; nor any other statutory defense.

In other words, the Roberts invention was not anticipated. Had it been, the claims would be invalid; but they were not found so. Since *Carlson* is not within any interpretation to which the claims are susceptible, such as to

limit their construction, and since respondent uses the Roberts combinations rather than *Carlson's*, there is no further capacity in which the reference properly could be considered pertinent.

The only other defense for which it might be invoked was that in view of the state of the art prior to the date of Roberts' work the improvements patented involved "merely the expected skill of those skilled in the art" (RC. 3, Answer). This defense, too, was not established. It is one to which *Carlson* is not pertinent, for his proposal was pending in secrecy until 1928 and was not a part of the teachings available to those skilled in the art at the date of the Roberts invention in 1923. To consider the matter otherwise is a pure fiction, which the law does not favor and which would establish a basis for the avoidance of patents having no relation either to the defenses provided by statute or to the question whether the matter claimed resulted from inventive ingenuity or had the character and effect of a patentable invention.

The Circuit Court of Appeals overlooked these considerations, and misinterpreted the basis and effect of the *Milburn Case*, 270 U. S. 390. It went so far as to give *Carlson* the fiction of having been published on its 1922 filing date, and to add the further fictions that Roberts presumably knew of *Carlson* at that time and that his claims somehow could not be good for what they cover because the advance acknowledged to have been made came "only a year after *Carlson* filed" (RE. 172). Yet the plain facts are that *Carlson* was not then published or known to Roberts or others, and in no respect did it reduce the ingenuity residing in, or the difficulty of bringing about, the Roberts invention. *Carlson*, indeed, is evidence of a far greater ingenuity and advance on the part of Roberts than was within the grasp of contemporary inventors in the art. If any part of the Roberts combinations corresponds to *Carlson's*, the whole of Roberts required not only such inven-

tiveness as *Carlson* displayed but also the further concepts that made the Roberts machine the exceptionally beneficial and successful advance that it actually was.

The Circuit Court of Appeals has given a greater effect to *Carlson's* conception than if it had been published and known long before Roberts' invention, for it does not anticipate, and the short time interval between the two conceptions was held as an element against Roberts. Yet the fact is, as it was in *O'Reilly v. Morse*, 15 How. (56 U. S. 62, 108, that " \* \* \* neither inventor can be justly accused of having derived any aid from the discoveries of the other".

While this court seems never to have decided the precise question here presented, the decision of the Circuit Court of Appeals is in logical conflict with *Mason v. Gram*, 23 Wall. (90 U. S.) 261, 274; *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 440, 441; *The Corn-Planter Patent*, 23 Wall. (90 U. S.) 181, 211; and other cases. In the case last cited, it was held that a mere application for a patent "can only have a bearing on the question of prior invention or discovery". That is the only capacity in which the *Milburn Case* held the application of an earlier-filed, copending patent to be pertinent.

The decision of the Circuit Court of Appeals conflicts with its own prior decisions and those of other federal courts in the cases cited at the footnotes on pages 13 and 14 of the petition.

If the decision in this case is the law, a drastic change seems requisite in the practice of the Patent Office. It is not now the practice, but would have to become so, to defer examination of and reject any pending application upon the existence of earlier-filed copending applications claiming different combinations, if they but show an analogous element; also, to assume that everything contained in pending applications was published and known to whomever may

have filed later; and also to base the determination of whether patentable invention was involved in any claim upon that assumption and the theoretical ease of combining with the assumed knowledge the further elements required by the later applicant's claim, rather than upon the character and effect of his claimed invention as a practical entity.

### **The Claims in Issue Were Clearly Infringed**

The opinion of the district court demonstrates this completely. The Circuit Court of Appeals conceded as much and found it necessary to change the claims in order to hold them not infringed.

Since respondent's machines embody the parts, improvements and combinations disclosed and claimed as the Roberts inventions, and operate in the same way to achieve the same result, they are infringements, however dissimilar their details and form may make detailed drawings of them appear in comparison with the patent drawings. *Cochrane v. Deener*, 94 U. S. 780, 789; *Deering v. Winona Harvester*, 155 U. S. 286, 302; *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 41, 42.

Respondent's expedient of substituting different motivations of parts and attendant changes of form to avoid the illustrations of the patents was an available one (RA. 408-409), and one that has been repeatedly rejected by the courts. *Blake v. Robertson*, 94 U. S. 728, 732, 733 (substitution of hydraulic for mechanical motivation); *National Ticket v. Automatic Ticket*, 40 F. (2d) 458, 459 (substitution of mechanical for electrical automatic control); *Mills Novelty v. Monarch*, 76 F. (2d) 653 (substitution of switch-to-rely motivation for mechanical lever).

## The Claims of the Separator Patent Were Improperly Held Anticipated By Holland

Courts have held patents increasingly accountable to the constitutional purpose of advancing the useful arts, but it has not heretofore been held permissible to invalidate a patent that unquestionably represents an important advance upon inferences and presumptions added to one that unquestionably did not.

In *Whitely v. Swayne*, 7 Wall. (74 U. S.) 685, 686, this court dismissed a suit on such a patent as *Holland's*, saying of the claimed improvements that:

"They never went into any useful or practical operation, and nothing more was heard of them from Steadman or any other person, for a period of six years";

and adding further:

"If any other person had chosen to take up the subject of the improvements, where it was left off by Steadman, he had a right thus to enter upon it, and if successful, would be entitled to the merit of them as an original inventor, for he is the first inventor, and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use".

There was a strong burden of proof upon respondent, an infringer, in asserting a prior invention to invalidate the Separator claims. *Coffin v. Ogden*, 18 Wall. (85 U. S.) 120. If any presumption of operability or sufficiency were otherwise attributable to *Holland's* disclosure it was overbalanced by the fact of *Holland's* uselessness during over 30 years of need and by the presumption of validity of the claims in suit.

"\* \* \* one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has

*more than a dubious preponderance*". *R. C. A. v. Radio Engineering*, 293 U. S. 1, 7, 8 (Italics added).

But since the description of *Holland's* Fig. 4, as invoked by respondent and interpreted by the Circuit Court of Appeals, was not the invention claimed in the patent, it acquired no presumptive utility from the grant. And since no evidence was given of its operability, sufficiency or utility, there was *nothing* to sustain respondent's burden of proof or to warrant holding *Holland* an anticipation. To recommend something in the specifications, where the claim does not embrace it, does not constitute it a portion of what was patented. *Scrall v. Jones*, 91 U. S. 171, 185, 186.

The description invoked therefore had no greater legal standing than a prior publication, and it was respondent's burden to show that it exhibited the Roberts invention in such full, clear and exact terms as to enable any person in the art to construct it and carry it into practical use. *Eames v. Andrews*, 122 U. S. 40, 66.

There was no evidence whatsoever to sustain this burden. The situation, indeed, is like that in *DuBois v. Kirk*, 158 U. S. 58, 65:

"The device, the operation of which is not very clearly shown in the patent, seems to have a different object from that of the Kirk patent, and employs quite a different means. \* \* \* Nor does defendant's expert make any reference to it. There is nothing in his testimony to indicate that the device which this patent describes accomplishes the same result or works in the same way as Kirk's invention; \* \* \*. We do not find it to have been an anticipation of the Kirk patent".

The very facts that *Holland* issued in 1902, that the art needed but lacked a successful syrup separator until the Roberts invention in 1933, and that respondent offered no evidence of having built or tested a device

according to *Holland*, show more conclusively than testimony the ineffectiveness of the disclosure. *Whitely v. Swayne, supra*; *Scovill v. Satter, infra*. As said of an alleged anticipation in *O'Reilly v. Morse*, 15 How. (56 U. S.) 62, 110, "We have nothing to show that his invention ever was or could be carried into successful operation". Yet here there was also undisputed testimony that the *Holland* proposal would be impractical to make, and that it is not operative to achieve syrup separations. To be as described the annular plate device would have to seal simultaneously upon *two* spaced circular seats of large diameter, on one of which syrup and sugar crystals would lodge with the result of holding the device up and preventing the requisite sealing upon the other. (RA. 673-675; Ex. 85, RB. 775, RA. 673)

Moreover, *Holland's* description of Fig. 4 is incomplete on its face, because it mentions nothing—seat, ledge or otherwise—to seal the outer edge of the plate (unless the plate be always in contact with the casing as he claimed), and it provides nothing for lifting and lowering the plate. There was no evidence that either of these elements might have been supplied by those skilled in the art, nor as to how. They never were. The Circuit Court of Appeals was not warranted in assuming their existence in operable form.

*Coffin v. Ogden*, 18 Wall. (85 U. S.) 120, 124:

"The law requires not conjecture, but certainty. If the question relate to a machine, the conception must have been clothed in substantial forms which demonstrate at once its practical efficacy and utility".

*Seymour v. Osborne*, 11 Wall. (78 U. S.) 516, 552:

"\* \* \* In order to constitute an invention, the party must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form".

See also *Ideal Stopper v. Crown Cork & Seal*, 131 Fed. 244 (C. C. A. 4th), *cert. denied*, 195 U. S. 633; *Scovill v. Sattler*, 21 F. (2d) 630, 634. The *Scovill* case was cited by the Circuit Court of Appeals to support the decision here, but it holds quite to the contrary as to the Reuthe patent there urged as an anticipation:

“\* \* \* it is inconceivable that the device suggested would not have been seized upon in the several years before Lowenstein's patent and embodied in a practical condenser. The fact that it did not so instruct condenser builders justifies the conclusion that the disclosures were not sufficient to instruct them.”

Furthermore, the ambiguities plain on the face of the *Holland* patent are themselves enough to prevent it anticipating the successful invention made by Roberts decades later, for *Holland* is susceptible to two conflicting interpretations, and the one required by his general description and claims could not anticipate. *Ideal Roller v. Sutherland Paper*, 96 F. (2d) 675, 677 (C. C. A. 6th); *In re Cramblet*, 62 F. (2d) 358, 359 (C. C. P. A.), and cases there cited.

### **Claim 8 of the Brake Cooling Patent Was Improperly Held Invalid**

The Circuit Court of Appeals has nullified the effect of this patent by deductive reasoning applied to claims 8 and 9. Yet there can be no doubt that the patent disclosed an advance, not previously anticipated or suggested, of extraordinary utility and success. It has been the instrument for providing high speed centrifugal machines, with all the great economies they import. The key to this important result is the constant maintenance of a body of water in the brake drum while it is either rotating or at rest. The brake drum arrangement of claim 8 is essential to that. Roberts conceived its usefulness, and it was never known before.

The claim may not explain the principles involved as perfectly as it might if written today. But to condemn it as being merely for "plugging up a hole" is to close one's eyes to the new function and result of the new structure it disclosed, and is to strike down the claim for the mere simplicity of its verbal distinction from the closest brake drum of the prior art. To condemn the claim as being "useless" simply disregards the fact that the structure it describes has been used successfully by petitioner, and by respondent in imitation, to accomplish new results. The reason given by the Circuit Court of Appeals for calling the claim useless was that it must otherwise presuppose a stoppage of the cool water supply, and that the latter could not be inferred because it occurs in claims 9 and 10. But the court then proceeded to confine claim 9 to details of form, and since claim 10 previously had been held narrow, the result of the court's reasoning was to leave no claim standing for either the maintenance of a body of water in the brake drum or the stoppage of the cool water supply in coordination with each stoppage of the machine. These, however, were held to be patentable features in the district court; they account for Roberts' success; and they were plainly the intended subjects of his claims.

It is no objection to the validity of claim 8, nor to the scope of claim 9, that but a simple change of prior structure was required to bring forth the improvement, for it had the practical character and effect of a meritorious advance. *Diamond Rubber v. Consolidated Tire*, 220 U. S. 428, 440, 441; *The Barbed Wire Patent*, 143 U. S. 275, 282;

"\* \* \* The difference between the Kelly fence and the Glidden fence is not a radical one, but slight as it may seem to be, it was apparently this which made the barbed-wire fence a practical and commercial success."

*Seymour v. Osborne*, 11 Wall. (78 U. S. 516, 548):

“\* \* \* if the change of construction and operation actually adapts the machine to a new and valuable use not known before, and it actually produces a new and useful result, then a patent may be granted for the same and it will be upheld as a patentable improvement”.

This court in *Deering v. Wmuna Harvester*, 155 U. S. 286, 302, held a claim valid over precisely the argument used against claim 8 by the Circuit Court of Appeals. The issue concerned claim 20 of the Steward patent. Defendant insisted that the claim was incomplete, inoperative and invalid, though it specified a new pivot board, in that the means necessary for holding and controlling the board were not recited; and it argued that the additional elements could not be read into the claim because they occurred in claim 21, which of course it had avoided. But the court stated:

“Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described in the patent as rendering it operative must be read into the claim. If Steward were in fact the first to invent the pivotal extension to a butt-adjuster, he is entitled to a patent therefor, though the infringer may make use of other means than those employed by him to operate it”.

Respectfully submitted,

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